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Paper No. 15

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Protestor

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Applicant

MAILED

FEB 05 2001

OFFICE OF DIRECTOR
GROUP

In re Application of:
Richard Chao
Application No. 09/182,862
Filed: October 21, 1998
Title: Auxiliary Lenses for Eyeglasses

DECISION RETURNING PAPERS
FILED UNDER 37 C.F.R. § 1.291(a)

The protest filed on October 5, 2000, under 37 C.F.R. § 1.291(a) is before the Group Director for consideration.

The protest is **RETURNED**.

BACKGROUND

On July 15, 2000, the examiner issued a first Office action.
On January 19, 2000, an extension of time (3 months) and an Amendment A was filed.
On June 6, 2000, a notice of a Non-Responsive Amendment was mailed.
On July 10, 2000, an Amendment B was filed.
On August 30, 2000, a supplemental Amendment C was filed.
On October 5, 2000, R. Joseph Trojan filed this protest.

REGULATIONS AND PRACTICE

37 C.F.R. § 1.291 provides:

(a) Protests by a member of the public against pending applications will be referred

to the examiner having charge of the subject matter involved. A protest specifically identifying the application to which the protest is directed will be entered in the application file if:

- (1) The protest is submitted prior to the mailing of a notice of allowance under 1.311; and
- (2) The protest is either served upon the applicant in accordance with 1.248, or filed with the Office in duplicate in the event service is not possible.

(b) Protests raising fraud or other inequitable conduct issues will be entered in the application file, generally without comment on those issues. Protests which do not adequately identify a pending patent application will be returned to the protestor and will not be further considered by the Office. A protest submitted in accordance with the second sentence of paragraph (a) of this section will be considered by the Office if the application is still pending when the protest and application file are brought before the examiner and it includes:

- (1) A listing of the patents, publications, or other information relied upon;
- (2) A concise explanation of the relevance of each listed item;
- (3) A copy of each listed patent or publication or other item of information in written form or at least the pertinent portions thereof; and
- (4) An English language translation of all the necessary and pertinent parts of any non-English language patent, publication, or other item of information in written form relied upon.

(c) A member of the public filing a protest in an application under paragraph (a) of this section will not receive any communications from the Office relating to the protest, other than the return of a self-addressed postcard which the member of the public may include with the protest in order to receive an acknowledgment by the Office that the protest has been received. In the absence of a request by the Office, an applicant has no duty to, and need not, reply to a protest. The limited involvement of the member of the public filing a protest pursuant to paragraph (a) of this section ends with the filing of the protest, and no further submission on behalf of the protestor will be considered, except for additional prior art, or unless such submission raises new issues which could not have been earlier presented.

M.P.E.P. § 1901.03 provides in pertinent part:

... new protests which also argue Office actions or replies or any matter beyond the new issue should not be accepted. Improper protests will be returned by the Examining Group Director. While improper protests will be returned, a new protest by an earlier protestor will be proper and can be entered if it is clearly limited to new issues which could not have been earlier presented, and thereby constitutes a new protest.

OPINION

Although a Reissue application file is open to the public, participation in the prosecution by a third party is prohibited by 37 C.F.R. § 1.291 (c). This protest includes comments directed to the response to the Office action filed January 19, 2000, and suggestions on how the response should be treated and addressed by the examiner. As such, it is hereby concluded that the comments in the protest are improper attempts to participate in the prosecution of the instant application.

Accordingly, pursuant to the M.P.E.P. § 1901.03, the protest will not be considered by the examiner and is being returned herewith.

Also, it is noted that the address at which the protest was served on the patent applicant is incorrect, a copy of the protest is being enclosed for the patent applicant.

A copy of this decision is being retained in the file record.

Inquiries regarding this decision should be directed to Clayton E. LaBalle at (703) 308-0519.


Janice A. Falcone

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JAF/cel

Enclosures: protest filed October 5, 2000 to Protestor
and copy of protest to Applicant